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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,069	10/27/2003	Brian Cruickshank	1030-23501	3808
30652	7590	11/16/2004	EXAMINER	
CONLEY ROSE, P.C. 5700 GRANITE PARKWAY, SUITE 330 PLANO, TX 75024			STEPHENSON, DANIEL P	
			ART UNIT	PAPER NUMBER
			3672	

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/694,069

Applicant(s)

CRUICKSHANK ET AL.

Examiner

Daniel P Stephenson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 10/031,456.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the anchor must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee et al. Lee et al. discloses a method for setting a whipstock and milling a lateral bore from a well. The method includes running a tool downhole that has an anchor (16) a whipstock (14) a cutting tool (22) and a motor (36). The assembly is oriented and the anchor is set without operating the motor. The motor is then used to activate the cutting tool to cut through the casing. The cutting tool can be used to drill into the formation. Since this is being oriented by the whipstock it is broadly read as being directionally drilled. All of this occurs in a single trip.

4. Claims 1 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Ross et al. Ross et al. discloses a method for setting a whipstock and milling a lateral bore from a well. The method includes running a tool downhole that has an anchor (18) a whipstock (16) a cutting tool (14) and a motor (col. 2 lines 59-60). The assembly is oriented and the anchor is set without operating the motor. The motor is then used to activate the cutting tool to cut through the casing.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey et al. '129 in view of Lee et al. and the Jeter. Bailey et al. '129 discloses a method for setting a whipstock and milling a lateral bore from a well. The method includes running a tool downhole that has an anchor (16) a whipstock (14) and a cutting tool (32). The assembly is oriented and

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the anchor is set at a certain fluid pressure. When cutting commences a second fluid pressure is used to actuate the tool in the drill string. The cutter cuts through the casing and drills into the formation. Since this is being oriented by the whipstock it is broadly read as being directionally drilled. All of this occurs in a single trip. Bailey et al. does not disclose that there is a downhole motor nor does it disclose that the motor is locked while the anchor actuates, nor that fluid flows through the motor during actuation. In addition, it fails to disclose neither that the motor is released at a predetermined pressure nor that it relocks.

Lee et al. discloses using a downhole motor in a one-trip milling apparatus. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the motor of Lee et al. in the apparatus of Bailey et al. '129. This would be done so that coiled tubing could be used to convey the system downhole without having to rotate the whole tool to drill.

Jeter (col. 1 lines 6-15 and 46-59) discloses a lockable motor for use in downhole applications in which the motor is unlocked by raising the pressure in the apparatus above a certain threshold value. Allowing tools below the motor to be actuated using the lower pressure applied through the motor. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the pressure activation system of Jeter on the apparatus of Bailey et al. '129 in view of Lee et al. This would be done so that the setting of the anchor and the cutter could be controlled with more accuracy by the operator of the system.

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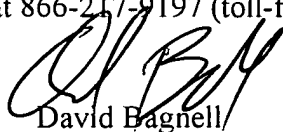
Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bailey '007, Bailey et al. '231 and Carter et al. all show similar elements to those of the present invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel P Stephenson whose telephone number is (703) 605-4969. The examiner can normally be reached on 8:30 - 5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on (703) 308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David Bagnell
Supervisory Patent Examiner
Art Unit 3672

DPS 